

REMARKS

Prosecution Summary. The pending application was filed more than five (5) years ago on October 24, 2003 with 25 claims. The first office action was filed three (3) years 9 months later on July 24, 2007. The presently addressed fourth office action was filed January 12, 2009.

Claim Summary. Claims 1-25 are pending. Claims 1, 8, and 16 are independent. Claims 1, 7, and 8 are herein amended without adding new matter to place them in better condition for allowance. The claims are not amended to overcome the cited art because, it is respectfully submitted, previously presented claims already overcome the cited art.

Office Action Summary. Previous rejections are withdrawn, but the claims are rejected on new grounds. The specification is objected to. Claims 1-5 are rejected under 35 U.S.C. 35 § 112, first paragraph. Claims 1-7 are rejected under 35 U.S.C. 35 § 112, second paragraph. Claims 8-15 are rejected under 35 U.S.C. 35 § 101. Claims 1-25 are rejected under 35 U.S.C. § 102(e). Claims 1-25 are rejected under 35 U.S.C. 35 § 103(a).

Remarks summary. Applicants respectfully traverse the objections and rejections. As explained in detail below, it is respectfully submitted that the claims are clearly allowable over the newly cited art. The rejections are clearly erroneous and should be withdrawn along with the finality of the rejection itself. Reconsideration in view of the foregoing amendments and following remarks is respectfully requested.

References to the Pending Application. Reference to paragraphs in the pending application are to the numbered paragraphs in the Published Application No. 2005/0091168.

Telephone Conversation With Examiner

Examiner Murdough and Examiner Fischer are thanked for the telephone conversation conducted on March 18, 2009. Proposed remarks were discussed. Proposed claim amendments were discussed. It was agreed that the objections to the specifications were overcome. It was

agreed that the rejection under 35 U.S.C. § 112 were overcome. Cited art was discussed. Examiners asked that the language of claim 8 be clarified. It appears that the proposed claim amendments overcome the rejections based on the cited art.

Objection to the Specification

The specification is objected to “as failing to provide proper antecedent basis for the claimed subject matter.” (Office Action, p. 2).

Without prejudice or disclaimer, amendments are made to various paragraphs to use claim terminology in the application other than in the claims to moot the objection.

It is of course understood that the original claims are part of the specification and, therefore, satisfy the written description requirement.

Paragraph 0021 is herein amended to generally point out that the application uses “[v]arious terms, including component, method, service, interface, module, routine and program, . . . interchangeably to refer to a group of computer-executable instructions stored in a computer-readable medium.” The term “component” was used in original claims 1, 2, 3 and 6 and original paragraphs 0019 and 0021, which defines “component” as part of a program module.

“Licensing component,” used in original claims 1, 2, 3 and 6, is used interchangeably with license or licensing service. Paragraph 0005 is amended to point this out.

“Right-consumption component” is used interchangeably with right consumption method. Paragraph 0006 is amended to point this out.

“Information-retrieval component” is used interchangeably with information-retrieval method. Paragraph 0008 is amended to point this out.

“Callable interface,” used in original claims 1, 2 and 4, is used interchangeably with API. Paragraph 0005 is amended to point this out.

“Handle-opening component” is used interchangeably with handle-opening method. Paragraph 0006 is amended to point this out.

“Asynchronous-context-initiator component” is used interchangeably with “asynchronous-context-initiator method.” Paragraph 0115 is amended to point this out.

“Class of machines,” used in original claim 7, is used interchangeably with group of machines. Paragraph 0232 is amended to point this out.

Having amended the specification to use claim terminology in the application besides only in the claims without adding new matter, Applicants respectfully request withdrawal of the objection to the specification.

Rejection of Claims 1-5 under 35 U.S.C. § 112, 1st ¶

Claims 1-5 are rejected under 35 U.S.C. 35 § 112, 1st paragraph, as allegedly not enabled. (Office Action, p. 3). As alleged in the instant Office Action “There is only a single means in these claims (a processor). ‘A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. § 112, first paragraph’ (MPEP 2164.08(a)). There is a lack of enablement because ‘the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.’” Applicants respectfully traverse.

Claim 1, as previously presented, is not a means claim, nor is it not enabled. There is no recitation of “means” in claim 1. Claim 1 is directed to a system comprising a processor, and as such, as previously and presently presented, is clearly enabled. FIG. 2 illustrates computer 110, which is also illustrated in FIG. 1. The application thoroughly discusses these embodiments and

others. This clearly enables one of ordinary skill to make and use the claimed system. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims 1-7 under 35 U.S.C. § 112, 2nd ¶

Claims 1-7 are rejected under 35 U.S.C. 35 § 112, 2nd paragraph, as allegedly indefinite for reciting “components.” (Office Action, pp. 3-4).

As previously indicated, paragraph 0021 is amended to point out that components are groups of computer-executable instructions stored in a computer-readable medium. Accordingly, Applicants respectfully request withdrawal of the rejection.

Rejection of Claims 8-15 under 35 U.S.C. § 101

Claims 8-15 are rejected under 35 U.S.C. 35 § 101 as allegedly claiming non-statutory subject matter. (Office Action, pp. 4-5).

Without prejudice or waiver, claim 8 (on which claims 9-15 depend) is amended to recite a method, executed by at least one machine. Of course a computer is a machine, but the specific term “machine” is mentioned in the specification in claims 6, 7, 15 and 19 and paragraphs 0005, 0031, 0046 and 0232-0234. Moreover, it is respectfully submitted that the Office Action misinterprets the law pertaining to 35 U.S.C. 35 § 101, which is summarized below for reference.

The argument made in the Office Action is not accurate according to the law.¹ Only a claim that is totally incapable of producing a useful result, such as one that is totally abstract without any tangible limitation, can support a rejection under 101.²

¹ “All that is necessary . . . to make a sequence of operational steps a statutory ‘process’ within 35 U.S.C. 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of ‘useful arts.’” *In re Musgrave*, 431 F.2d 882, 893 (C.C.P.A. 1970).

"[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." (MPEP 2106 II. C. at p. 2100-8).

"[The preamble] is not ignored in determining whether the subject matter as a whole is statutory, for all of the claim steps are in implementation of th[e] method [recited in the preamble]." *Arrhythmia Research Tech., Inc. v. Corazonix Corp.*, 958 F.2d 1053, 1059 (Fed. Cir. 1992).

"If an invention has a well-established utility, rejections under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph, based on lack of utility should not be imposed. . . . For example, if an application teaches [an aspect of] a well-known [subject], and those skilled in the art at the time of filing knew that [the subject] had a well-established use, it would be improper to reject the claimed invention as lacking utility solely because of [a perceived] omitted statement of specific and substantial utility." (MPEP 2107.02 II. B. at p. 2100-29).

A computer-related invention is patentable subject matter, i.e., it is "statutory [if it is] capable of causing functional change in [a] computer [or otherwise] defines structural and functional interrelationships [with] computer software and hardware components which permit the [claimed] functionality to be realized."). (MPEP § 2106.01 at 2100-18). Obviously, a computer is patentable subject matter as is a data structure and a programmable storage device storing

² "If . . . claims [cover a machine implemented process and not the mental implementation thereof, the claims] overcome [a] § 101 rejection, since the machine-implemented process is clearly statutory." *In re Mahony*, 421 F.2d 742, 745 (C.C.P.A. 1970).

"To violate [35 U.S.C.] 101 the claimed device must be totally incapable of achieving a useful result." *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571, 24 USPQ2d 1401, 1412 (Fed. Cir. 1992) (emphasis added).

executable instructions.³ There will obviously be functional change in a computer in order for it to determine the relative position of elements in a data structure.

Unpatentable “abstract ideas” are defined as “nonfunctional descriptive material.” (MPEP 2106.01 at p. 2100-17.) However, “[w]hen functional descriptive material is recorded on some computer readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.” (MPEP 2106.01 at p. 2100-17).

Thus, “a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program’s functionality to be realized, and is thus statutory.” (MPEP 2106.01 at p. 2100-18.) “[W]here the computer is executing the computer program’s instructions, USPTO personnel should treat the claim as a process claim.” (MPEP 2106.01 at p. 2100-18.)

“Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material *per se* and hence nonstatutory.” (MPEP 2106.01 at p. 2100-18).

³ “[C]omputer programs embodied in a tangible medium, such as floppy diskettes, are patentable subject matter under 35 U.S.C. § 101 and must be examined under 35 U.S.C. §§ 102 and 103.” *In re Beauregard*, 53 F.3d 1583, 1584 (Fed. Cir. 1995).

Data structures are statutory subject matter because, “more than mere abstraction, . . . data structures are specific electrical or magnetic structural elements in a memory . . . that provide increased efficiency in computer operation.” *In re Lowry*, 32 F.3d 1579, 1583-84 (Fed. Cir. 1994).

“[I]f a machine is programmed in a certain new and unobvious way, it is physically different from the machine without that program; its memory elements are differently arranged. . . . certainly a ‘new and useful improvement’ of the unprogrammed machine has been [invented], and Congress has said in 35 U.S.C. 101 that such improvements are statutory subject matter for a patent.” *In re Bernhart*, 417 F.2d 1395, 1400 (C.C.P.A. 1969).

Clearly then, a rejection under 35 U.S.C. § 101 cannot be maintained. Thus, it is respectfully submitted, claims 8-15 are clearly directed to patentable subject matter. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101.

Rejection of Claims 1-25 under 35 U.S.C. § 102(e)

Claims 1-25 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,697,948, issued to Rabin *et. al.*, (hereinafter referred to as “Rabin”). (Office Action, pp. 5-12). Applicants respectfully traverse the rejection.

It is respectfully submitted that the comparison of the claimed subject matter to Rabin is clearly made in error.

The claimed subject matter involves a common licensing component used by licensable computer programs. Each license comprises right(s) and associated data. The licensing component maintains the licenses in a license store and dynamic data (used to validate the licenses) in a trust store. The licensing component has an interface callable by the computer programs to: (a) determine if an identified right can be exercised and/or (b) retrieve data related to an identified right. Thus, claimed computer programs are integrated with and actively involved in license enforcement and call a common component for assistance in enforcement.

In contrast to the claimed subject matter, Rabin teaches passive licensable software (SW1-3 111-113) not engaged in license enforcement. Instead, Rabin teaches that supervising program (SP) 209 (a) monitors use of passive software, (b) intercepts attempts to use it, (c) communicates with external guardian center (GC) 103 by “call-up” to determine whether to permit or deny a user’s attempt to use the passive software, and (d) enforces the determination made by GC 103. FIGS. 4 and 8 illustrate Rabin’s functionality. Passive licensable software (SW1-3 111-113) take no part in license enforcement. The following quotes from Rabin support the foregoing summary of Rabin:

“A user device receives and installs an instance of software and securely receives a tag uniquely associated with that instance of software. The user device includes a supervising

program which detects attempts to use the instance of software and which verifies the authenticity of the tag associated with the instance of software before allowing use of the instance of software. The supervising program on the user device verifies the authenticity of the tag and maintains or stores the tag in a tag table . . . The supervising program rejects the instance of software if the tag associated with the software is not authentic. . . . The tags created by the tag server include at least one of a name of an instance of software, a unique number of an instance of software, and/or a hash function value on portions of an instance of software. . . . each tag [may] further compris[e] a unique identifier of the supervising program [and maybe] at least one fingerprint computed on portions of the instance of software associated with the tag." (Rabin, col. 3, l. 53 – col. 4, l. 9).

"The determination of whether or not a user device 104 through 107 can use an instance of software is based on a tag processing procedure called a call-up (explained in detail later) that is performed between the user device and the guardian center 103." (Rabin, col. 28, ll. 18-22). "Periodically, a call-up process is performed . . . to effectively re-authenticate the validity and enforce the usage supervision policy of each tag TAG_INST_SWn in the tag table 210." (Rabin, col. 47, ll. 38-41).

"A device (e.g. 104) cannot use an instance 111 of a vendor's 101 software 111 unless the device 104 stores or has access to the associated valid tag 120, preferably maintained in the device's 104 tag table 210 (shown in detail in FIG. 6) and unless that associated tag 120 has a usage status (column 2 in FIG. 6) in the tag table 210 that allows or indicates proper usage for the associated instance 111. (2) Through mandated call-up procedures (FIGS. 12, 13A&B) . . . between a device (e.g. 104) and the guardian center 103, the guardian center 103 can supervise, authenticate, track, validate and generally control tag properties and ensure that the instance of software 111 associated with a tag 120 is used in accordance with the vendor's 101 usage supervision policy." Rabin, col. 35, ll. 10-25.

"FIG. 8 shows the high level steps performed by the system 109 of this invention when a user 213 attempts to use an instance of software (INST_SW) 111-114 on a user device 104. In step 270, the user 213 interfaces with the user input/output mechanism 204 on the user device 104 to use an instance of the software 111-114. In step 271, the supervising program (SP) 209 intercepts the call to invoke use of the instance of software 111-114. At this point, the supervising program (SP) 209 will ensure that the instance of software 111-114 requested has a tag TAG_INST_SW that indicates a "CONTINUED" status in the tag table 210. However, before checking the individual tag TAG_INST_SWn, in a preferred embodiment, the supervising program (SP) 209 ensures that the tag table 210 itself is in valid or updated state. By valid state, what is meant is that the tag table 210 is not outdated and in need of a call-up procedure to update its contents. Accordingly, in step 272, the supervising program (SP) 209 accesses the tag table 210 to determine if a call-up to the guardian center 103 (FIG. 2) is required at the current time." (Rabin, col. 47, ll. 14-33).

Thus, it is clear that Rabin teaches SP 209 (in combination with GC 103) enforces licenses for passive licensable software SW1-3 111-113. Licensable software SW1-3 111-113 do not call SP 209 as a service because SW1-3 111-113 are not actively engaged in license enforcement.

Rabin is required to keep enforcement separate from licensable software because Rabin is designed to protect both licensable software (which is tagged when licensed), untagged software and all intellectual property rights. Rabin's overarching plan to protect all intellectual property rights requires SP 209 (and GC 103) to act independently of tagged and untagged instances of software to enforce licenses and otherwise protect intellectual property rights. A considerable amount of Rabin is dedicated to discussing this. (See, e.g., Rabin, Summary (a) col. 8, l. 60 – col. 9, l. 14; (b) col. 9, l. 61 – col. 10, l. 30; (c) col. 15, ll. 32-67; (d) col. 17, ll. 6-33; (e) col. 20, l. 61-col. 21, l. 46; (f) col. 23, ll. 17-58; (g) FIG. 7). Since untagged software is not licensable, and if knowingly infringing on intellectual property rights, it would not be designed to seek enforcement of a license or otherwise participate in enforcement of intellectual property rights.

As explained in detail below, it is respectfully submitted that arguments in the Office Action equating Rabin's components to claimed components are made in error. With regard to citations, it is noted that Rabin's "Summary" runs from column 2 to column 25.

As the first example of erroneously equating Rabin's components to claimed components, consider that Claim 1 recites "the licensing component expos[es] a callable interface to the [licensable] computer program." With reference to Rabin's FIG. 4, the Office Action equates (a) the claimed licensing component to Rabin's supervising program (SP) 209 and (b) the claimed computer program to SW1-3 111-113. Thus, having inserted the allegedly equivalent components into the claim language, in order to anticipate the claim language Rabin must teach that "[SP 209] expos[es] a callable interface to [SW1-3 111-113]." However, Rabin clearly does not teach this.

The Office Action argues Rabin teaches this in column 39, lines 43-60, which states, "supervising program (SP) 209 . . . uses an . . . API provided by the operating system 207 to

interface with and control certain functions of the operating system 207.” The cited API is not an API callable by licensable software SW1-3 111-113 to access SP 209. This cited portion of Rabin clearly fails to teach what it must to anticipate the claim language. Rabin’s passive licensable software SW1-3 111-113 and passive unlicensable software 129 don’t call SP 209 because they are not actively participating in license or other intellectual property enforcement. As opposed to licensable software actively engaged in license enforcement, Rabin’s license enforcement is only effective if SP 209 and GC 103 are installed and operational.

“Since the supervising program (SP) 209 serves as an interface between the user 213 and the instances of installed software 111-114 on a user device 104, the supervising program 209 implements the usage supervision mechanisms described herein.” (Rabin, col. 54, ll. 34-38). “In step 271, the supervising program (SP) 209 intercepts the call to invoke use of the instance of software 111-114.” (Rabin, col. 47, ll. 19-21). “[T]he supervising program 209 denies use of the instance of software 111-114 in step 276.” (Rabin, col. 49, ll. 23-24).

As a second example of erroneously equating Rabin’s components to claimed components, consider that Claim 1 requires the interface called by the licensable computer program to comprise a rights-consumption component and an information retrieval component. Rabin fails to teach this. However, the Office Action equates: (a) the callable interface to the API called by SP 209 to control OS 207; (b) the right-consumption component to either SP 209 or external GC 103 (ambiguous citation/argument); and (c) the information retrieval component to storage 200. This is clearly a discombobulated argument at least because (a) SP 209 and GC 103 are not components of the API called by SP 209 and (b) the storage 200 is not a component of the API.

As a third example of erroneously equating Rabin’s components to claimed components, consider that claim 1 recites that each license comprises a right and a set of data, which the information retrieval component provides to the computer program upon request. Rabin fails to teach this. However, the Office Action equates Rabin’s tags 120 with the claimed licenses and

then equates the rights in the license to “access” and the set of data to “access times” in FIG. 14. This is a clearly discombobulated argument because “access” and “access times” are not part of tags 120. Additionally, Rabin does not teach that the “access times” are requested by or provided to licensable software SW1-3 111-113.

The foregoing remarks apply equally well, in whole or in part, to all claims 1-25. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-25 under 35 U.S.C. § 102(e).

Rejection of Claims 1-25 under 35 U.S.C. § 103(a)

Claims 1-25 are rejected under 35 U.S.C. 35 § 103(a) as unpatentable over Rabin in view of Official Notice of use of handles. (Office Action, pp. 12-13). Applicants respectfully traverse.

Previous remarks apply equally well here to overcome the rejection of claims 1-25 under 35 U.S.C. 35 § 103(a) on the same grounds asserted under 35 U.S.C. 35 § 102(e). Rabin does not teach what it is purported to teach and, further, fails to suggest the claims. The assertion of Official notice with respect to handles fails to make up for the lack of disclosure by Rabin.

In case the Examiner subsequently considers using Rabin in rejection under 35 U.S.C. 35 § 103, the Examiner should be mindful of the prohibitions against rendering the system or method in a prior art reference unsatisfactory for its intended purpose, changing the principle of operation and combining references that teach away from their combination.

Any “proposed modification can not render the prior art unsatisfactory for its intended purpose” (MPEP 2143.01.V). Further, “[t]he proposed modification cannot change the principle of operation of a reference.” (MPEP 2143.01.VI). Further still, “[i]t is improper to combine references where the references teach away from their combination.” M.P.E.P. § 2145 X.D.2.

Each "prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed subject matter." M.P.E.P. § 2141.02 VI. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir., 1994).

Any amendments made during prosecution of the pending application are without abandonment of subject matter. Applicants expressly reserve the right to, in the pending application or any application related thereto, reintroduce any subject matter removed from the scope of claims by any amendment and introduce any subject matter not present in current or previous claims.

CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that this application is in condition for allowance. Reconsideration of this application and an early Notice of Allowance are respectfully requested.

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/Joseph F. Oriti/
Joseph F. Oriti
Registration No. 47,835

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439